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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,819	09/05/2003	Ming T. Chen		9412
24987	7590	05/20/2004		
MARCUS G THEODORE, PC 466 SOUTH 500 EAST SALT LAKE CITY, UT 84102			EXAMINER BLAU, STEPHEN LUTHER	
			ART UNIT 3711	PAPER NUMBER

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/656,819

Applicant(s)

CHEN, MING T.

Examiner

Stephen L. Blau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/5/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Specification*

1. The disclosure is objected to because of the following informalities: On page 1 line 11 the word "grains" is misspelled.

Appropriate correction is required.

### *Drawings*

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Reference number 10 (Page 10 lines 3,4 and 6) is not in the drawings. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

3. New corrected drawings are required in this application because informal drawings are supplied. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

*Claim Rejections - 35 USC § 112*

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 line 17 is indefinite in that the statement “behind the most probable hitting surface” is indefinite. What is probable for one golfer may not be what is probable to another. The examiner recommends removing the words “most probable”. Claim 1 lines 27-28 are indefinite in that the statement “with most mass placed along the lower portion of the club face most probable to impact a golf ball during repetitive strokes” is indefinite. What is probable for one golfer may not be what is probable to another. The examiner recommends removing the entire statement. Claim 1 line 44 is indefinite in that the statement “the most probable contact segments of”. This statement is indefinite for the same reason. The examiner recommends removing the entire statement. Claims 3-4 are indefinite in that the these conditions will be different for each golfer and most likely change over time for each golfer due to many different variables. The examiner recommends canceling these claims. Claims 2 and 5 are rejected for depending on rejected base claims.

*Allowable Subject Matter*

6. Claims 1-2 and 5 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action. None of the prior art discloses or renders as obvious a first reinforcing sole weight attached behind a back surface of a the club along the bottom sole with the height rising from a low point proximate a heel increasing along a sole to a peak reinforcing the middle of a lower back surface and thereafter declining to a low point proximate a toe, the depth of its sole mass increasing in thickness from a least thickness from a least thickness proximate the heel and increasing along the bottom of the sole in depth to reinforce the middle and thereafter decreasing in thickness to a least thickness proximate a toe along a sole, and a third center weight attached to a back surface behind the hitting surface above a sole weight in addition to the other elements of structure claimed. Golden discloses a first reinforcing sole weight behind a back surface of a the club along the bottom sole with a first reinforcing sole weight along the bottom sole with the height rising from a low point proximate a heel increasing along a sole to a peak reinforcing the middle of a lower back surface and thereafter declining to a low point proximate a toe, the depth of its sole mass increasing in thickness from a least thickness from a least thickness proximate the heel and increasing along the bottom of the sole in depth to reinforce the middle and thereafter decreasing in thickness to a least thickness proximate a toe along a sole (Fig. 5). Golden lacks a first reinforcing sole weight attached behind a back surface and a third center weight above a sole weight. Nishitani, Madore, Gorman, and Penna disclose a first reinforcing sole weight attached behind a hitting surface. Best (Des. 401,637) discloses a first reinforcing sole weight

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attached behind a hitting surface and a third center weight above the sole weight (Fig. 7). Best lacks a first reinforcing sole weight attached behind a back surface of a club along the bottom sole with the depth of its sole mass increasing in thickness from a least thickness from a least thickness proximate the heel and increasing along the bottom of the sole in depth to reinforce the middle and thereafter decreasing in thickness to a least thickness proximate a toe along a sole. Long discloses a first reinforcing weight attached behind a back surface of a the club with the depth of the mass increasing in thickness from a least thickness from a least thickness proximate the heel and increasing to reinforce the middle and thereafter decreasing in thickness to a least thickness proximate a toe (Fig. 20). Long lacks the thickness changing a long the sole and a third center weight attached to a back surface behind the hitting surface above a sole weight.

### *Conclusion*

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (703) 308-2712. The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Greg Vidovich whose telephone number is (703) 308-1513. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858. (TC 3700 Official Fax 703-872-9306)

slb/ 15 May 2004



**STEPHEN BLAU**  
**PRIMARY EXAMINER**